

REMARKS

Applicants reaffirm the election of Group I, Claims 1-12, without traverse. Claims 13-18 have been cancelled.

Claims 1-12 were rejected under 35 USC § 103(a) as obvious over Thorsteinson et al, EP 480537 ('537). This rejection is respectfully traversed.

To establish a *prima facie* basis for obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination must be found in the prior art, and not based on applicant's disclosure [MPEP § 2142; *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).]

The catalyst in the '537 reference contains potassium as part of one half of a redox-half reaction pair. The catalyst in the instant application comprises potassium as a promoter. The '537 reference is directed to the direct oxidation of ethylene to ethylene oxide. It is well known in the art that catalysts used for the direct ethylene oxide process do not necessarily work for the direct propylene oxide process. There is no suggestion or motivation in the reference or in the art to modify the reference such that the alkylene used is propylene instead of ethylene. Because the chemistry is different, propylene is not "the next member of the series". Therefore, there would be no expectation of success with such a substitution and the claimed combination is not found in the reference. In view of the above, Applicants assert that a *prima facie* basis for obviousness has not been established, and respectfully request that the rejection be withdrawn.

Claims 1-12 were rejected under 35 USC § 103(a) as obvious over the '537 reference further in view of Kirk-Othmer, page 288. This rejection is respectfully traversed. The Examiner uses the Kirk-Othmer reference to show that propylene is commonly oxidized in the gas phase over silver catalysts to propylene oxide. Propylene oxide is not commonly produced in this way. As discussed on pages 277 to 278 of volume 20 of the Kirk-Othmer reference, the two commercial processes for production of propylene oxide are the chlorohydrin process and the hydroperoxide process. The reference also states that the direct oxidation of propylene is a *potential* commercial process. In contrast, as stated on page 923

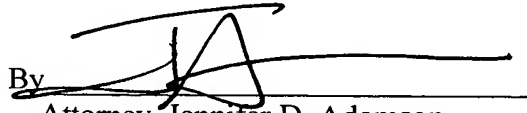
of volume 9 of the Kirk-Othmer reference, all the ethylene oxide production in the world is achieved by the direct oxidation process. Therefore, it would not be obvious to use propylene in the epoxidation process taught by the '537 reference. In view of this, Applicants assert that a *prima facie* basis for obviousness has not been established, and respectfully request that the rejection be withdrawn.

CONCLUSION

In view of the above remarks, Applicants believe the instant application to be in condition for allowance and respectfully request that such action be taken.

Respectfully submitted,

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